

## REMARKS

### A. Status of the Claims

Claims 1, 6-12, 15, and 18-26 were pending at the time of the action. Claims 2-5, 13, 14, 16, 17, and 27-46 were previously canceled. The claims stand rejected, variously, under 35 U.S.C. §102 and §103. The specific grounds for rejection, and applicants' response thereto, are set out in detail below.

### B. Priority

The examiner has deemed the present application entitled only to its actual filing date in 2001 on the basis that the parent application, U.S. Serial No. 08/847,063 ("the '063 application"), of which the present application is a *continuation*, allegedly does not support the currently pending claims. In particular, the examiner acknowledges that the parent discloses yeast as a host cell, but argues that it "fails to describe or support ... a method of selecting [a] yeast host cell that expresses a desired antibody or fragment thereof." As explained below, the rejection cannot be correct, and therefore it is traversed.

The examiner acknowledges that the present application is a continuation of the parent '063 application. It is also a fact that the specification of the present application, *including the original claims*, was identical to that of the '063 application as filed – only subsequent amendments introduced yeast host cell recitations. Therefore, *by definition*, the present application when filed contained the identical disclosure and support as the '063 application when filed.

Importantly, the examiner is not advancing any rejection under 35 U.S.C. §112, first paragraph for either or both of lack of written description and enablement of the instant claims. That constitutes an *admission* that the present application's specification adequately supports the

pending claims. Thus, since the parent '063 application's specification is *identical* to the present application, there can be no way that it is defective for these very same claims, and thus they must derive a priority basis in the '063 application. Simply put, since the applications as filed were identical, either *both* applications are adequately supportive, or *neither* are. As a matter of law, it is impossible for one to have support, and the other to lack it – which is what the examiner argues now. Reconsideration and withdrawal of the improper priority determination is therefore requested.

### C. Anticipation Rejections

#### I. *U.S. Patent 5,866,344*

Claims 1, 6-12, 15 and 18-23 are rejected under 35 U.S.C. §102(b) over U.S. Patent 5,866,344 (“the ‘344 patent”). As explained above, applicants are entitled to *at least* the filing date of the parent '063 application, which predates the issuance of the '344 patent. Therefore, a rejection based on the use of the '344 patent as a §102(b) reference is improper. Reconsideration and withdrawal of the rejection is therefore requested.

Interestingly, by rejecting the claims specified above as anticipated by the '344 patent, the examiner also is *admitting* on the record that the '344 patent both describes each element of the claimed invention, and provides an enabling disclosure. It is simply left to point out that the '344 patent is part of the priority chain for the present application. Given the examiner's admission, that means that, *by definition*, the priority date for the instant claims is identical to that of the '344 patent (May 23, 1995), and thus it also fails to qualify as §102(e) art. Reconsideration and withdrawal of the rejection is therefore requested.

## **2. U.S. Patent 6,300,065**

Claims 1, 6-12, 15 and 18-23 are rejected under 35 U.S.C. §102(b) over U.S. Patent 6,300,065 (“the ‘065 patent”). As explained above, applicants are entitled to *at least* the filing date of the parent ‘063 application, which predates the issuance of the ‘065 patent. Therefore, a rejection based on the use of the ‘065 patent as a §102(b) reference is improper. Reconsideration and withdrawal of the rejection is therefore requested.

Also as explained above, applicants are entitled to *at least* the filing date of the parent ‘344 patent for the rejected claims, which predates the filing of the provisional application upon which the ‘065 patent is based. Therefore, no rejection based on the ‘065 patent as a §102(e) reference is possible. Reconsideration and withdrawal of the rejection is therefore requested.

## **3. U.S. Patent 6,214,613**

Claims 1, 6-9 and 18-21 are rejected under 35 U.S.C. §102(e) over U.S. Patent 6,214,613 (“the ‘613 patent”). As explained above, applicants are entitled to *at least* the filing date of the parent ‘344 patent for the rejected claims, which predates the §102(e) date (July 12, 1996) of the ‘613 patent. Therefore, a rejection based on the use of the ‘613 patent as a §102(e) reference is improper. Reconsideration and withdrawal of the rejection is therefore requested.<sup>1</sup>

## **D. Obviousness Rejections**

A variety of obviousness rejections are advanced. However, for any rejection relating to claims 6-12, 15 or 18-23, and based on either the ‘344 patent, the ‘065 patent or the ‘613 patent, as explained above, these references are not prior art to these claims. As such, all of those rejections are improper.

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<sup>1</sup> The priority date of the ‘344 patent (May 23, 1995) also defeats the publication date of the publication date for the PCT application corresponding to Higuchi *et al.*

Turning to the rejection of claims 1, 6-12, 15 and 18-23 over U.S. Patent 5,789,208 ("the '208 patent") in view of Boder *et al.*, optionally taken with U.S. Patent 5,646,011, U.S. Patent 4,918,162, or U.S. Patent 5,081,030, applicants traverse on the grounds that the **admitted** priority date for these claims is the same as the '344 patent, *i.e.*, May 23, 1995. The publication date set out on the PTO-892 for Boder *et al.* is June of 1997.<sup>1</sup> This occurred **after** the filing of the application on which '344 patent is based, and thus Boder *et al.* is not available as prior art against these claims.

Finally, all that remains are rejections of claims 24-26 over the '344, '065 or '613 patents in combination with Boder *et al.* As noted immediately above, Boder *et al.* was published in June of 1997. This is after the May 1, 1997 filing date of the parent '063 application, to which **all** of the pending claims can properly claim support. As such, these rejections to are improper.

Applicants respectfully submit that, as discussed above, the various references, and combinations thereof, cannot be applied against the instant claims due to their respective priority dates. As such, all the rejections are based on incorrect legal and factual presumptions. Reconsideration and withdrawal of the rejections is therefore requested.

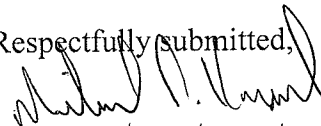
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<sup>1</sup> Even the parent '063 application's filing date pre-dates Boder *et al.*

E. Conclusion

In light of the foregoing, applicants respectfully submit that all claims are in condition for allowance, and an early notification to that effect is earnestly solicited. The examiner is invited to contact the undersigned attorney with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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Date: November 3, 2010